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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/530,238

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Kumiko Ono

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EXAMINER

SCHWARTZ, DARREN B

ART UNIT

PAPER NUMBER

2435

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/530,238	Applicant(s) ONO ET AL.	
	Examiner DARREN SCHWARTZ	Art Unit 2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2009 and 03 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 14, 15 and 37-61 is/are pending in the application.
- 4a) Of the above claim(s) 1-4, 7-9, 11, 15, 37-58 and 61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5, 6, 10, 14, 59 and 60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant amends claims 5, 10, 14 and 59. Claims 1-4, 7-9, 11, 15, 37-58 and 61 are withdrawn.

Claims 5, 6, 10, 14, 59, 60 are examined.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03 September 2009 has been entered.

Response to Arguments

Applicant's arguments filed 06 August 2009 have been fully considered but they are not persuasive.

1. Applicant argues on the following on page 30 of Remarks: "Specifically, paragraph [0035] of Holmes points out by the Examiner discloses that 'The Basic Certificate may include other fields that have not been shown. Such fields include, for example, a validity field specifying the period of validity of the digital certificate, a version field, etc.' Therefore, Holmes discloses the 'period of validity of the digital certificate.'"

The Examiner conquers with this evaluation of Holmes as applied to the claimed invention.

Applicant continues: “However, Holmes fails to suggest or disclose that the period of validity of the address information is identical to that of the digital certificate. Accordingly, Holmes and Ono, taken alone or in combination, fail to disclose or suggest 'a storing unit that stores/storing the address information and the public key certificate of the first communication device with a validity period of the address information being set to be identical to that of the public key certificate.”

The Examiner disagrees. Applicant's and applicant's representative are reminded that a prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention; see *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) [MPEP: 2141.02 VI].

While the Examiner addressed Figure 1, element 150 (the central database) as “a storing unit,” however, Figure 1, element 110 (the subscriber computer system or client) also comprises a storing unit and further records in memory the requested digital certificate.

Holmes et al (U.S. Pat Pub 20020116610), hereinafter referred to as Holmes teaches the computer system 110 includes a memory and software running thereon for digitally signing and verifying digital objects using PKI certificates (§28). The certification authority transmits to the client the certificate according to Figure 1, element 165 (§38). The period of validity of the digital certificate may be stored in the certificate

Figure 3, elt 300 (¶35). The client stores the very same created / transmitted certificate stored in the database as explicitly stated in ¶38. Further, the client derives a Working Certificate via components of the Basic Certificate as shown in Figure 5.

While it is a subject of interpretation as to what applicant regards as “to be identical to,” there are two valid interpretations of Holmes when applied to the amended limitation. Since the certificate itself is stored on the very same client that issued the request, it has the “identical” certificate issued by the authority and cached by the database. Another interpretation is the client derives a certificate corresponding to validated information corresponding to the certificate received by the certification authority.

The Examiner sustains.

The fact that the Examiner may not have specifically responded to any particular arguments made by Applicant and Applicant’s Representative, should not be construed as indicating Examiner’s agreement therewith.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 5, 6 and 59 are rejected under 35 U.S.C. 102(b) as being anticipated by Holmes et al (U.S. Pat Pub 2002/0116610 A1), hereinafter referred to as Holmes.

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Re claim 5: Holmes teaches a server that establishes a session between first and second communication devices, comprising:

a receiving unit [Fig 1, elt 140: certification authority computer system] that receives, from the first communication device [Fig 1, elt 110: subscriber computer system], a request for registering an address information on the first communication device and issuing a public key certificate of the first communication device (§10; §31; §44);

an issuing-and-validating unit that issues the public key certificate of the first communication device to the first communication device (§5; §10; §49); and

a storing unit [Fig 1, elt 110] that stores the address information and the public key certificate with a validity period of the address information being set to be identical to that of the public key certificate (§28; §39; Fig 9: §45; §63).

Re claim 6: Holmes teaches the receiving unit receives, from the second communication device [Fig 1, elt 110: recipient computer system], a request for validating the public key certificate issued to the first communication device, and the issuing-and-validating unit validates the public key certificate and indicates a result of the validation to the second communication device (page 2, left column, §28, line 17 - page 2, right column, §28, line 8; §45; §49).

Re claim 59: Holmes teaches the receiving unit [Fig 1, elt 140: certification authority computer system] receives, from the first communication device [Fig 1, elt 110: subscriber computer system], a request for registering an address information and a public key certificate of the first communication device (§10; §31; §44);

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the issuing-and-validating unit validates the public key certificate (§5; §10; §49),
and

the storing unit device [Fig 1, elt 110: recipient computer system] stores the
address information and the public key certificate with a validity period of the address
information being set to be identical to that of the public key certificate (§28; §39; Fig 9:
§45; §63).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed
or described as set forth in section 102 of this title, if the differences between the
subject matter sought to be patented and the prior art are such that the subject
matter as a whole would have been obvious at the time the invention was made
to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negated by the manner in which the invention was
made.

3. Claims 10, 14 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable
over Holmes et al (U.S. Pat Pub 2002/0116610 A1), hereinafter referred to as Holmes,
in view of Ono et al (U.S. Pat Pub 2002/0035685 A1), hereinafter referred to as Ono.

Re claims 10 and 14: Holmes teaches a method for a server to control a session
between first and second communication devices and a computer readable recording
medium storing a program for a server to control a session between first and second
communication devices, the program making a computer execute (Abstract; §52-§53):

receiving, from the first communication device, a signal for requesting a registration of an address information on the first communication device;

determining whether or not the signal includes a request for issuing a public key certificate of the first communication device to the first communication device (¶10; ¶31; ¶44);

storing the address information and the public key certificate of the first communication device with a validity period of the address information being set to be identical to that of the public key certificate (¶28; ¶39; Fig 9: ¶45; ¶63); and

transmitting, to the first communication device, a signal that indicates a completion of registering the address information and includes the public key certificate (¶5; ¶28).

However, Ono teaches:

issuing the public key certificate when the signal is determined to include the request for issuing the public key certificate (Fig 2, elt P12: ¶76).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Holmes with the teachings of Ono, for the purpose of providing explicit instructions to a serving entity; servers provide a plurality of functions and it is widely accepted that servers require explicit instructions of prior to executing a particular function.

Re claim 60: The combination of Holmes and Ono teaches the signal transmitted at the transmitting further includes a digital signature of the server (Holmes: Fig 3, elt 330; Fig 6, elt 635; ¶34).

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the text of the passage taught by the prior art or disclosed by the examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DARREN SCHWARTZ whose telephone number is (571)270-3850. The examiner can normally be reached on 7am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571)272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. S./

Examiner, Art Unit 2435

/Kimyen Vu/

Supervisory Patent Examiner, Art Unit 2435